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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,939	10/23/2003	Scott J. Clifford	16143	6309
4859	7590	01/28/2005		
MACMILLAN SOBANSKI & TODD, LLC ONE MARITIME PLAZA FOURTH FLOOR 720 WATER STREET TOLEDO, OH 43604-1619				
			EXAMINER LAZOR, MICHELLE A	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/691,939	CLIFFORD ET AL.	
	Examiner	Art Unit	
	Michelle A Lazor	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 17, drawn to a painting apparatus, classified in class 239, subclass 750.
 - II. Claims 18 – 21, drawn to a method, classified in class 427, subclass 458.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus, such as a painting apparatus that does not use an arm.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William Clemson on 1/5/05 a provisional election was made without traverse to prosecute the invention of a painting apparatus, claims 1 – 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18 – 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The use of the trademark Lauramid has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 contains the trademark/trade name Lauramid. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe nylon or polyamide and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. (U.S. Patent No. 5772125) in view of Wacker et al. (U.S. Patent No. 5100057).

Ehinger et al. disclose a painting apparatus comprising an arm (5 or 52); a color changer (9 or 59) mounted external to said housing; a paint canister (6 or 56) mounted adjacent an inside side of said housing; a paint transfer line (13 or 62) connecting said color changer to an interior of said paint canister; a canister manifold (57) (column 4, lines 4 – 14); and a piston ram mounted in said housing and being connected to said paint canister (Figures 1 and 2; column 2, lines 49 – 62); but does not specifically disclose housing formed of a non-conductive material. However, Wacker et al. disclose using a non-conductive material for a housing used in a similar environment (column 5, lines 39 – 52). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use non-conductive material for the housing to improve safety of the apparatus.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 1 above, in view of Diamond et al. (U.S. Patent No. 3724755).

Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose said housing to be formed of Lauramid or a nylon material. However, Diamond et al. disclose using a non-conductive or insulating material, such as nylon (column 5, lines 63 – 68). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use nylon since it is well known and conventional to use nylon as an insulating material.

12. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 1 above, in view of Gimple et al. (U.S. Patent No. 5413283).

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Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose said paint transfer line to be formed of an FEP (fluorinated ethylene propylene) material. However, Gimple et al. disclose using FEP for conduits or paint transfer lines (column 1, line 56 – column 2, line 3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use FEP for conduits or paint transfer lines to avoid pinholing (column 1, lines 59 – 62).

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 1 above, in view of Malarz et al. (U.S. Patent No. 4402234).

Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose a wrist attached to said arm wherein said wrist is formed of an electrically insulating material and is adapted to mount a paint applicator. However, Malarz et al. disclose using a wrist attached to said arm wherein said wrist is adapted to mount a paint applicator (Figures 1 and 2; column 2, lines 45 – 66). Malarz et al. does not disclose using an electrically insulating material; however, Wacker et al. discloses using an electrically insulating material as discussed above. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a wrist attached to said arm wherein said wrist is adapted to mount a paint applicator to improve mobility of said paint applicator; and it would have been obvious to one of ordinary skill in the art to use an electrically insulating material to improve safety of the apparatus.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 8 above, in view of Kamimura (U.S. Patent No. 5063828).

Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose said piston ram to include a piston releasably attached to a ram body by a ram locking key. However, Kamimura discloses a piston releasably attached to a ram body by a ram locking key

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(Abstract; column 3, line 65 – column 4, line 17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a piston ram which includes a piston releasably attached to a ram body by a ram locking key to avoid the piston from moving inadvertently.

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 8 above, in view of Cote et al. (U.S. Patent No. 6250502).

Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose a canister quick disconnect. However, Cote et al. disclose a canister quick disconnect (column 2, line 57 – column 3, line 41). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a canister quick disconnect in order to allow simplified cleaning or replacement of parts exposed to dispensing fluid for ease of service with minimum down time for service (column 3, lines 38 – 41).

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al., Wacker et al. and Cote et al. as applied in Claim 10 above, in view of Pratt (U.S. Patent No. 6261042).

Ehinger et al., Wacker et al. and Cote et al. disclose all the limitations of Claim 10, but do not disclose said disconnect includes convex locking means on said piston ram releasably engaged with concave locking means on said paint canister. However, Pratt discloses disconnect means to include convex locking means on said piston ram releasably engaged with concave locking means on said paint canister, or the equivalent (Claim 9). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include convex locking means on said piston ram releasably engaged with concave locking means on said paint canister so that the piston does not have a tendency to rotate once the assembly is installed (column 7, lines 21 – 28).

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17. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Wacker et al. as applied in Claim 1 above, in view of Minoura et al. (U.S. Patent No. 5851292).

Ehinger et al. and Wacker et al. disclose all the limitations of Claim 1, but do not disclose said piston ram to include a ball screw and cooperating ball screw nut and including a drive motor connected to said ball screw. However, Minoura et al. disclose said limitations (Figures 1 and 2; column 7, lines 46 – 60). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a piston ram that includes a ball screw and cooperating ball screw nut and including a drive motor connected to said ball screw to increase efficiency of cleaning the paint canister (Abstract).

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. in view of Cote et al.

Ehinger et al. disclose a painting apparatus comprising an arm (5 or 52); a paint canister (6 or 56) mounted inside said arm; and a piston ram mounted in said housing and being connected to said paint canister (Figures 1 and 2; column 2, lines 49 – 62); but does not specifically disclose a canister quick disconnect releasably attaching said paint canister to said piston ram. However, Cote et al. disclose a canister quick disconnect (column 2, line 57 – column 3, line 41). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a canister quick disconnect in order to allow simplified cleaning or replacement of parts exposed to dispensing fluid for ease of service with minimum down time for service (column 3, lines 38 – 41).

19. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Cote et al. as applied in Claim 13 above, in view of Kamimura.

Ehinger et al. and Cote et al. disclose all the limitations of Claim 13, but do not disclose a piston releasably attached to a ram body by a ram locking key. However, Kamimura discloses a

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piston releasably attached to a ram body by a ram locking key (Abstract; column 3, line 65 – column 4, line 17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a piston ram which includes a piston releasably attached to a ram body by a ram locking key to avoid the piston from moving inadvertently.

20. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Cote et al. as applied in Claim 13 above, in view of Pratt.

Ehinger et al. and Cote et al. disclose all the limitations of Claim 13, but do not disclose said disconnect means to include convex locking means on said piston ram releasably engaged with concave locking means on said paint canister. However, Pratt discloses disconnect means to include convex locking means on said piston ram releasably engaged with concave locking means on said paint canister, or the equivalent (Claim 9). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include convex locking means on said piston ram releasably engaged with concave locking means on said paint canister so that the piston does not have a tendency to rotate once the assembly is installed (column 7, lines 21 – 28).

21. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehinger et al. and Krueger et al. as applied in Claim 13 above, in view of Minoura et al.

Ehinger et al. and Krueger et al. disclose all the limitations of Claim 13, but do not disclose said piston ram to include a ball screw and cooperating ball screw nut and including a drive motor connected to said ball screw or piston ram. However, Minoura et al. disclose said limitations (Figures 1 and 2; column 7, lines 46 – 60). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a piston ram that includes a ball screw and cooperating ball screw nut and including a drive motor connected to said ball screw or piston ram to increase efficiency of cleaning the paint canister (Abstract).

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Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshida et al. (U.S. Patent No. 6164561) disclose said piston ram to include a ball screw including a drive motor connected to said ball screw (Figures 8 – 10; column 13, line 52 – column 14, line 4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232. The examiner can normally be reached on Thurs - Fri 5:45 - 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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1/13/04



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